

## REMARKS

Applicant is in receipt of the Office Action mailed May 10, 2005. Claims 1-7, 9-15, 17-25, and 31 were rejected. Claims 26-30 and 32-36 were objected to. Claims 1-7, 9-15, and 17-36 are currently pending in the application.

### Claim Objections

The Examiner objected to claims 26-30 and 32-36 as being dependent upon a rejected base claim but indicated that these claims would be allowable if re-written in independent form. Applicant respectfully thanks the Examiner for consideration of these claims. However, Applicant has not re-written these claims in independent form at this time because the rejected base claim is believed to be allowable, as argued below.

### Claim Rejections

Claims 1 – 7, 11 – 15, 18 – 25, and 31 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,401,216 to Meth et al. (hereinafter “Meth”) in view of U.S. Patent No. 6,002,868 to Jenkins et al (hereinafter “Jenkins”). Applicant respectfully traverses this rejection.

As Examiner is certainly aware, “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)” as stated in the MPEP §2142 (*emphasis added*).

As held by the U.S. Court of Appeals for the Federal Circuit in *Ecolochem Inc. v. Southern California Edison Co.*, an obviousness claim that lacks evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the

claimed invention is defective as hindsight analysis. Furthermore, the showing of a suggestion, teaching, or motivation to combine prior teachings “must be clear and particular. . . Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’.” *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.

Applicant respectfully submits that there is no clear and particular teaching or suggestion in the prior art for combining Meth and Jenkins to produce the combination of elements recited in the present claims. The Examiner states that, “One of ordinary skill in the art at the time of invention would have been motivated to combine the teachings because Meth teaches checkpointing an application. Meth teaches that checkpointing allows the application to be restarted from a checkpoint, rather than from the beginning, in the case of a failure during execution. Jenkins teaches a specific type of application that could be utilized with the checkpoint method of Meth to provide a reliable, failure-tolerant test executive sequence.” However, simply stating that Jenkins’ application could be used with the checkpoint method of Meth to yield an improvement is no more than hindsight. As discussed above, there must be a clear and particular initial suggestion in the prior art to make the combination, and the Examiner has provided no evidence of such a suggestion in the prior art.

Furthermore, the execution models taught in Meth and Jenkins are substantially different from one another, and Applicant respectfully submits that it is entirely non-obvious to combine Meth and Jenkins. Meth relates to the field of parallel programs and teaches a system for performing checkpoint and restart of a parallel program. Meth teaches that the parallel program includes processes that execute independently and communicate with each other by passing messages back and forth (Col. 5, lines 51-57). Each individual process of the parallel program is responsible for taking its own checkpoints and for re-starting itself in the event of failure (Col. 6, lines 49-53).

Jenkins relates generally to a diagnostic testing tool for testing personal computers. In contrast to the parallel program execution taught in Meth, Jenkins teaches

a diagnostic application comprised of a front end module and several tiers of lower level modules. The front end module is responsible for interacting with the user and communicating with the lower level modules to initiate processes. At the lowest level are a plurality of diagnostic library modules (DLs) which function to interact with the hardware and software to provide identification and diagnostic information back to the front end (Col. 1, line – 60 Col. 2, line 6).

Thus, in Meth, a plurality of processes essentially act as peers and execute in parallel with each other, passing messages back and forth to communicate. In contrast, in Jenkins, a front end module drives a hierarchical tier of modules which eventually results in the invocation of various DL modules to perform diagnostic functions. Due to these substantial differences, Applicant submits that it is not at all obvious how the checkpointing method that Meth teaches for a parallel program would be applied to the execution model taught in Jenkins.

Meth teaches that each individual process of the parallel program is responsible for taking its own checkpoints. Thus, the most likely way to combine Meth with Jenkins would be to modify the DL modules of Jenkins so that each DL module takes its own checkpoints. However, claim 1 recites in pertinent part that, “the test executive engine is further operable to perform one or more snapshots of the execution of the test executive sequence”. Thus, in the present claims, the test executive engine acts as a central entity that performs snapshots of the execution of the test executive sequence. There is nothing in Meth that would suggest to have a central entity that performs snapshots in this manner, and in fact Meth teaches away from this.

Furthermore, Applicant respectfully submits that a *prima facie* case of obviousness cannot be properly made because Meth and Jenkins are non-analogous art with respect to each other. Meth’s invention belongs purely to the field of processing parallel programs (see “Technical Field” section, Col. 1, lines 33 – 35). Meth contains no teaching or disclosure whatsoever regarding the use of a diagnostic application for testing personal computer systems or other devices. In contrast, Jenkin’s invention belongs to the field of automated testing of personal computer systems and the like (Col. 1, lines 5-10). Jenkins contains no teaching or disclosure regarding parallel programming. The field of parallel program processing is not analogous art with the field of automated

device testing, and one skilled in the art of developing diagnostic applications for testing personal computer devices cannot be presumed to be aware of art in the field of processing parallel programs.

Thus, for at least the reasons provided above, Applicant respectfully submits that claim 1, and claims dependent thereon, are patentable over the cited references. Independent claims 11 and 18 recite similar features as claim 1, and so for at least the reasons provided above, Applicant submits that these claims, and claims respectively dependent thereon, are also allowable.

Applicant also submits that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the independent claims have been shown to be patentably distinct, a further discussion of the dependent claims is not necessary at this time.

As per claim 20, the claim recites a computer-implemented method for storing execution progress of a test executive sequence hierarchy, the method comprising in pertinent part, “executing the test executive sequence hierarchy on a computer system, wherein the test executive sequence hierarchy includes a plurality of test executive sequences related to each other according to a hierarchical relationship, wherein each of the test executive sequences includes a plurality of steps”. For example, as described on p. 15 of the present application, in one embodiment the hierarchy of test executive sequences may be structured in a tree form, wherein each child test executive sequence in the tree is called by a parent test executive sequence.

Jenkins does not teach the concept of a test executive sequence hierarchy that includes a plurality of test executive sequences related to each other according to a hierarchical relationship. It is noted that at Col. 13, lines 7-8, Jenkins teaches that, “Referring now to FIG. 4A, the test definition file 400a is shown as a structure comprised of a hierarchy of objects.” However, this merely means that objects in the test definition file are arranged in a hierarchy. FIG. 4A does not show, and Jenkins does not describe, multiple test executive sequences that are arranged as a hierarchy relative to each other, where each test executive sequence includes a plurality of steps. Applicant thus respectfully submits that claim 20 is allowable over the cited references.

## CONCLUSION

Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5150-50100/JCH.

Also enclosed herewith are the following items:

- Return Receipt Postcard
- Request for Approval of Drawing Changes
- Notice of Change of Address
- Check in the amount of \$ \_\_\_\_\_ for fees ( \_\_\_\_\_ ).
- Other:

Respectfully submitted,



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Jeffrey C. Hood  
Reg. No. 35,198  
ATTORNEY FOR APPLICANT(S)

Meyertons, Hood, Kivlin, Kowert & Goetzel PC  
P.O. Box 398  
Austin, TX 78767-0398  
Phone: (512) 853-8800  
Date: 8/10/2005 JCH/JLB